

Patent No. 5,836,622). Further, the Patent Office rejected Claims 1-3, 7-9 and 11 under 35 U.S.C. §103(a) as being unpatentable over *Walz* (U.S. Patent No. 5,664,725) in view of *Schwan et al.* (U.S. Patent No. 5,524,934). Still further, the Patent Office rejected Claims 4-6, 10, 12 and 24-26 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Schwan et al.* and further in view of *Petkovsek* (U.S. Patent No. 5,697,648). Moreover, Applicant notes with appreciation that the Patent Office indicated that Claims 13-23 are in allowable form.

By the present response, Applicant submits that the remarks and arguments below overcome the rejections by the Patent Office and places the application in condition for allow. Notice to the effect is requested.

With respect to the rejection of Claims 1-8 under 35 U.S.C. §112, first paragraph, the Patent Office alleges:

Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, has possession of the claimed invention. Claim 1 discloses a mailing assembly comprising a label "wherein the front side and back side of the label include shading and printing". These limitations are not disclosed in the specification.

Contrary to the assertions of the Patent Office, Applicant submits that a label "wherein the front side and the backside of the label include shading and printing" as required by Claim 1 is described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the Applicant, at the time the application was filed, had possession of the claimed invention. More specifically, the specification of the present invention clearly states:

However, the indicia including the special services designator 316 may be printed using only a single color. For example, if the designator 316 refers to certified mail, the certified mail designator 316 may be printed green to indicate the generally recognized color indicative of certified mail. The remaining indicia and any shading to be printed upon the label 310 may also be green. This allows the indicia and the designator 316 to utilize only one color thereby simplifying the printing process requiring a single color print cartridge, ribbon or the like.

Like the front side of the label 310, the back side may have indicia printed thereupon using the single color utilized for the front side of the label 310. Therefore, as previously indicated, only one print cartridge or ribbon or the like may be used to print the label 310.

Therefore, Applicant asserts that the rejection of Claims 1-8 under 35 U.S.C. §112, first paragraph, is improper and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 1-3, 7-9 and 11 under 35 U.S.C §103(a) as being anticipated by *Fabel*, Applicant

submits that the rejection is improper for the reasons that follow.

In the Office Action, the Patent Office alleges:

Fabel discloses in Fig. 13, a mailing assembly and a method of preparing a mail piece comprising: a label (72) having a front side (74) and a backside (75); includes a return postcard (86, which includes upper section (146) and lower section (144)), having printed information relating to delivery of the mail piece, formed with a designator section (158) indicative of a special service wherein the designator section is contained within the exterior sides (lines 184) that defines the return postcard (86) and further contains a machine readable code (Col. 10, lines 36-43); and further wherein the label (72) includes shading and printing, wherein the shading and printing on the label are a single color (Col. 9, lines 26-33, wherein the information indicia is "printed in a green color"; and in Col. 10, lines 20-26, wherein the return receipt has a background color "using the same used to pre-print information on sender's receipt section"). *Fabel* further discloses a first and second anchor portion (tabs 177) being removably attached to the post card through the use of the perforated lines (184), wherein the first anchor portion has an adhesive (76, as seen in Fig. 14) on a backside (seen in Fig. 14) of the first anchor portion; and wherein a backing strip (178) is disposed of the adhesive (76) on the backside of the first and second anchor portion.

However, *Fabel* does not disclose wherein the front side and the back side of the label include shading and printing.

In regards to Claim 1, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the shading and printing at any location on the label, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Therefore, it would be obvious to place the shading and printing at any desired location since applicant has not stated why it would

be critical to place the shading and printing at a particular location or side.

However, independent Claim 1 requires a label having a front side and a backside wherein the front side and the backside of the label includes shading and printing which are a single color.

Independent Claim 9 requires a method for preparing a mailpiece for delivery by a special service having the step of providing a label which has a front side and a backside wherein the front side of the label includes shading and printing which are a single color and the backside includes indicia.

Fabel merely teaches a single form which provides various elements required for sending certified mail. As shown in Figure 13, *Fabel* teaches that the block 158 is located on the upper section 146 of the return receipt 86. Further, *Fabel* teaches that "the sender's address and the POSTNET code representing the ZIP code within the sender's address are printed in appropriate locations on lower section 144." (See *Fabel*, column 10, lines 51-54.) Moreover, *Fabel* teaches that the return receipt 86 is "divided into a lower section 144 and an upper section 146 by a fold line 148." (See *Fabel*, column 10, lines 15-18.)

Nowhere does *Fabel* teach or suggest a special service mailing assembly having a label which has a front side and a backside wherein the front side and the backside of the label include shading and printing which are a single color as required by Claim 1. *Fabel* merely teaches that the "front sheet 74 is preferably white, with pre-printed information on sender's receipt section 84 being printed in a green color used by the U.S. Postal Service to signify such documents associated with certified mail." (See *Fabel*, column 9, lines 30-33.) Moreover, the Patent Office admits that "*Fabel* does not disclose wherein the front side and the back side of the label include shading and printing." Therefore, *Fabel* does not teach a label having a front side and a backside wherein the front side and the backside include shading and printing which are a single color as required by Claim 1.

Nowhere does *Fabel* teach or suggest a method for preparing a mailpiece for delivery by a special service having a label with a front side including shading and printing which are a single color and a backside including indicia as required by Claim 9. *Fabel* merely teaches that "the interior surface of back sheet 75, release materials 77, such as silicone release coatings, are placed over

panels 98 and 100, which underlie label areas 90 and 92, respectively." (See *Fabel*, column 8, lines 47-50) Further, *Fabel* teaches that the "back sheet 75 also includes a transverse tear line 102 underlying transverse tear line 87 of front sheet 74, and a fold line 104 underlying fold line 96 of front sheet 74." (See *Fabel*, column 8, lines 53-56) Still further, the Patent Office admits that "*Fabel* does not disclose wherein the front side and the back side of the label include shading and printing." Therefore, *Fabel* does not teach a label with the front side of the label including shading and printing which are a single color and the backside including indicia as required by Claim 9.

Moreover, with respect to the rejection of Claims 1-3, 7-9 and 11 under 35 U.S.C. §103(a), one of ordinary skill in the art at the time of Applicant's invention would never have been motivated to modify *Fabel* in the manner suggested by the Patent Office in formulating the rejection of the claims under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the art would suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common

to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teaching of the reference in its entirety, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Fabel* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art at the time of Applicant's invention would have been led to modify *Fabel* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). Even assuming that one having ordinary skill in the art could somehow have modified *Fabel*, the reference still lacks the critical features and steps positively

recited in Claims 1 and 9, respectively. Accordingly, the rejection of Claims 1 and 9 under 35 U.S.C. §103(a) is improper and should be withdrawn. Notice to that effect is requested.

Applicant respectfully submits that, for the reasons provided above, the rejection of Claims 1-3, 7-9 and 11 under 35 U.S.C. §103(a) is improper and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 1-3, 7-9 and 11 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Schwan et al.*, Applicant submits that this rejection is improper for the reasons that follow.

In the Office Action, the Patent Office alleges:

Walz discloses in Fig. 1, 4 and 5, a mailing assembly and a method of preparing a mailpiece comprising a label (10) having a front side (Fig. 1) and a backside (Fig. 5) wherein the label (10) includes a postcard (which is the area (A) defined between perforated lines 24 and 26, Col. 4, lines 40-53) and an integrally formed designator section (73) that is contained within the exterior sides (24a and 26a), a first and second anchor portion (58 and 59) having an adhesive (16) on the backside, and a backing strip (49) disposed over the adhesive on the backside of the anchor (seen in Fig. 5); and wherein the backside includes indicia (Col.4, lines 40-58).

However, the Patent Office admits that "*Walz* does not disclose: a designator section indicative of a special

service and has a machine readable code; and a label including shading and printing wherein the shading and printing are a single color."

Additionally, the Patent Office alleges:

Schwan et al. discloses in Fig. 2, 3 and 5, a record in the form of a label (Col. 1, lines 10 and 11; and Col. 7, lines 14-16) having selected portions for forming areas of a plurality of different colors, wherein coatings of colorless color formers and developers are initially combined (upon application of an imaging force) to form colored visible areas (Fig. 3 and 4). The coatings (color formers and color developers) can be applied in selected areas on the label, and when combined can form blocks of background color(s) or may be applied so as to form symbols or indicia (Col. 4, lines 58-61 and Claims 1-3), both in many different shades or hues (Col. 4, lines 14-20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Walz's* label to include a label having self contained coatings to form a shading and printing of a particular color as set forth by *Schwan et al.* for the purpose of providing an advantage that both information and colored areas on a document can be achieved by printing in a single pass through a thermal or impact printer and further wherein the colored label can be used as an indication of where the label and its accompanying contents are to be routed.

Moreover, the Patent Office alleges:

In regards to Claims 9 and 11, the method for preparing a mail piece for delivery by providing a label having a front side and a back side, wherein the

label includes a postcard and an integrally formed designator section that is contained within exterior sides that defines the return postcard; providing one anchor on an exterior side of the postcard, wherein the anchor portion has a backside, and further wherein the backside includes adhesive. Furthermore, Walz teaches the method step of removing a backing strip (49) disposed over the adhesive (as seen in Fig. 5); attaching the label to a mail piece (Col. 4, lines 63-67 and Col. 5, lines 1-3); and printing information on the return postcard relating to delivery of the mail piece by a special service (Col. 4, lines 35-53).

Furthermore in regards to Claim 9, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the shading and printing at any location on the label, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Therefore, it would be obvious to place the shading and printing at any desired location since applicant has not stated why it would be critical to place the shading and printing at a particular location or side.

In regards to Claim 1, 7, 9 and 11, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section and postcard, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate. Even further, a recitation of the intended use of the claimed invention must result in

a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As set forth above, independent Claims 1 and 9 require a label which has a front side and a backside wherein the label includes a return postcard integrally formed with a designator section indicative of a special service. Further, Claim 1 requires the front side and the backside of the label to include shading and printing which are a single color. Moreover, Claim 9 requires the front side of the label to include shading and printing which are a single color and the backside to include indicia.

Walz merely discloses a multi-part mailing form having two superimposed sheets of material wherein detachable areas of the upper sheet are detached and secured to an item to be mailed, and sections of the sheets are separable from one another. Contrary to the assertions of the Patent Office, *Schwan et al.* merely teach a sheet containing surface coatings of selected color formers and color developers which, when subjected to heat or pressure,

combine to form different colored areas on the sheet. Further, *Schwan et al.* merely teach that "the coating may be applied in selected areas which can form blocks of background color, or they may be applied so as to form images, symbols, stripes, borders, and the like." (See *Schwan et al.*, column 4, lines 57-60.) Still further, *Schwan et al.* teach that "both the colored areas and printed information on the record can be formed in a single printing pass." (See *Schwan et al.*, column 6, lines 2-4.)

Neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest a label which has a front side and a backside wherein the label includes a return postcard integrally formed with a designator section indicative of a special service as required by Claim 1 and Claim 9. The Patent Office admits that *Walz* does not disclose a designator section indicative of a special service. Moreover, nowhere do *Schwan et al.* disclose a label which includes a return postcard integrally formed with a designator section indicative of a special service.

Neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest a label wherein the front side and the backside include shading and printing which are a single color as required by Claim 1. Additionally,

neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest a label wherein a front side includes shading and printing which are a single color and a backside which includes indicia as required by Claim 9. The Patent Office admits that *Walz* does not disclose a label including shading and printing wherein the shading and printing are a single color. *Schwan et al.* merely teach that "the invention has the advantage that both information and the colored areas on the document may be achieved by printing in a single pass through a thermal or impact printer." (See *Schwan et al.*, column 7, lines 7-10.) Moreover, nowhere does *Schwan et al.* disclose a label having a front side and a backside which includes shading and printing which are a single color as required by Claims 1. Furthermore, nowhere does *Schwan et al.* disclose a label having a front side which includes shading and printing wherein the shading and printing are a single color and further wherein the backside includes indicia as required by Claim 9

Moreover, a person of ordinary skill in the art would never have been motivated to combine the teachings of *Walz* with *Schwan et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C.

§103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of the *Walz* and *Schwan et al.* patents in mind, as enumerated above, no reason or suggestion in the evidence of record exists why

one of ordinary skill in the art would have been led to combine *Walz* with *Schwan et al.* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103. Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent Office, the references still lack the novel features and the novel steps positively recited in Claims 1 and 9, respectively. Accordingly, the rejection of Claims 1 and 9 under 35 U.S.C. §103(a) is improper and should be withdrawn. Notice to that effect is requested.

Applicant respectfully submits that, for the reasons provided above, the rejection of Claims 1-3, 7-9 and 11 under 35 U.S.C. §103(a) is improper and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 4-6, 10, 12 and 24-26 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Schwan et al.* and further in view of *Petkovsek*, Applicant submits that this rejection is improper for the remarks that follow.

In the Office Action, the Patent Office alleges that:

Walz as modified *Schwan et al.* discloses a mailing assembly and method of preparing a mail piece comprising all the elements as set forth in

Claims 1 and 9, and as set forth above. *Walz* also discloses an associated backing sheet (14) attached to the backing strips (49) and the postcard (70).

However, *Walz* does not disclose a printer track strip associated (Webster Dictionary defines as "combined") extending outside the exterior sides of the postcard wherein the strip includes a hole and is removably attached to the anchor position.

Petkovsek discloses in Fig. 5, a mailing assembly having a label sheet (11) having a width between a first end (E1) and a second end (E2); wherein the first end has a printer track strip (56) with holes (54) extending outside the exterior sides of the postcard (18) at one end of the assembly (E1) and is removably attached to the anchor portion (28).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Walz's* and *Schwan et al.'s* mailing assembly by replacing the backing strip associated with the assembly with backing strip containing a printer track strip as taught by *Petkovsek* for the purpose of allowing the mailing assembly to be passed through a printer.

Dependent Claim 4 requires a special service mailing assembly having a printer track strip associated with the label extending outside one of the exterior sides of the return postcard wherein the printer track strip includes a hole. Further, dependent Claim 5 requires a special service mailing assembly having a hole disposed therein. Moreover, dependent Claim 6 requires a special service mailing assembly having a width defined between a first end

and a second end wherein the first end includes holes disposed therein.

Dependent Claim 10 requires a method for preparing a mailpiece for delivery by a special service having the step of providing a hole in the label. Moreover, dependent Claim 12 requires a method for preparing a mailpiece for delivery by a special service having the step of providing a printer tracking strip removably attached to the anchor portion.

The Patent Office alleges that *Petkovsek* discloses a mailing assembly having a backing sheet (11) with a printer track strip (56) with holes (54) extending outside the exterior sides of the postcard (18) and is removably attached to the anchor portion (28). However, *Petkovsek* merely teaches an assembly which includes a single sheet constructed in such a way that one portion of the sheet provides a label and the other portion provides a return postcard or other special service form for attachment to an envelope in its assembled position.

Applicant submits that *Petkovsek* does not teach or suggest that which is not taught by *Walz* and/or *Schwan et al.* as set forth above. Namely, *Petkovsek* does not disclose a label having a front side and a backside which

includes shading and printing wherein the shading and printing are a single color as required by Claim 1. Further, Petkovsek does not disclose a label having a front side and a backside wherein the front side of the label includes shading and printing wherein the shading and printing are a single color and further wherein the backside includes indicia as required by Claim 9. Still further, Petkovsek does not teach or suggest a label having a designator section indicative of a special service which is contained completely within exterior sides that define the return postcard as required by Claims 1 and 9.

Moreover, no reason or suggestion exists in Petkovsek, Walz and/or Schwan et al. to modify Walz with Schwan et al. and/or Petkovsek. Accordingly, a *prima facie* case of obviousness has not been established as required under 35 U.S.C. §103. Therefore, the rejection of Claims 4-6, 10 and 12 under 35 U.S.C. §103(a) is improper and should be withdrawn. Notice to that effect is requested.

Independent Claims 24-26 require a special service mailing assembly having a label which includes a return postcard integrally formed with a designator section indicative of a special service wherein the designator section is contained completely within exterior sides that

define the return postcard and further wherein the label includes shading and printing which are a single color.

None of *Walz*, *Schwan et al.* or *Petkovsek*, taken singly or in combination, teach or suggest a label which includes a return postcard integrally formed with a designator section indicative of a special service wherein the designator section is contained completely within exterior sides that define the return postcard and further wherein the label includes shading and printing which are a single color as required by Claims 24-26, respectively. The Patent Office admits that *Walz* does not disclose a designator section indicative of a special service and a label including shading and printing wherein the shading and printing are a single color. Moreover, nowhere do *Schwan et al.* or *Petkovsek* disclose a label which includes a return postcard integrally formed with a designator section indicative of a special service wherein the designator section is contained completely within exterior sides that define the return postcard and further wherein the label includes shading and printing which are a single color.

Moreover, a person of ordinary skill in the art would never have been motivated to modify the teachings of *Walz*

with *Schwan et al.* and/or *Petkovsek* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

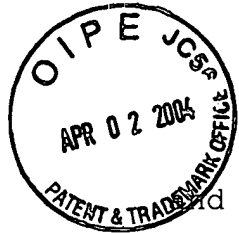
That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of the *Walz*, *Schwan et al.* and *Petkovsek* patents in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Walz* with *Schwan et al.* and/or *Petkovsek* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103. Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent Office, the references still lack the novel features positively recited in Claims 24-26. Accordingly, the rejection of Claims 24-26 under 35 U.S.C. §103(a) is improper and should be withdrawn. Notice to that effect is requested.

Applicant respectfully submits that, for the reasons provided above, the rejection of Claims 4-6, 10, 12 and 24-26 under 35 U.S.C. §103(a) is improper and should be withdrawn. Notice to that effect is requested.

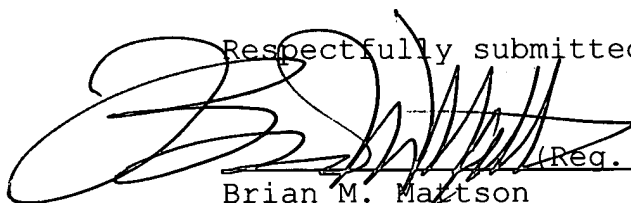
Claims 2-8 depend from independent Claim 1; and Claims 10-12 depend from independent Claim 9. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional structural elements



and novel steps of Applicant's novel assembly and method for preparing mailpieces, respectively.

In view of the foregoing remarks, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



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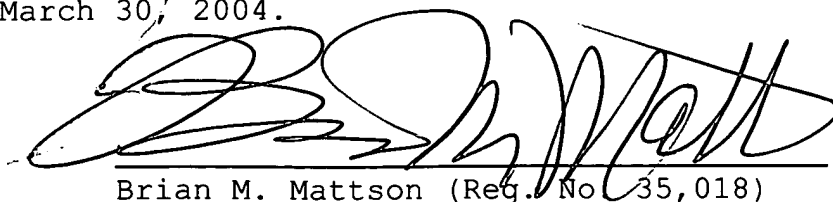
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CERTIFICATE OF MAILING

I hereby certify that this **RESPONSE** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to MS Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 30, 2004.



Brian M. Mattson (Reg. No. 35,018)